

REMARKS

This is in response to the Office Action mailed on January 12, 2005, and the references cited therewith.

Claim 3 and 19 are amended, and claims 25 and 26 are added; as a result, claims 1-15, and 19-26 are now pending in this application.

Applicants do not admit that the references cited in the Office Action are prior art, and reserve the right to swear behind such references at a later date. Nevertheless, Applicants respectfully submit that the claims are distinguishable over the references for at least the reasons argued below.

Change of Correspondence Address

Applicants have filed herewith a Change of Correspondence Address form, which changes the correspondence address for the present application to:

Schwegman, Lundberg, Woessner & Kluth
P.O. Box 2938
Minneapolis, MN 55402

Applicants respectfully request that all future correspondence be directed to this address.

§102 Rejection of the Claims

Claims 1-15 and 19-23 were rejected under 35 USC § 102(e) as being anticipated by Helfman (U.S. 6,119,135).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed

invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Applicants respectfully submit that the Office Action did not make out a *prima facie* case of anticipation for the following reasons:

Claims 1 and 25: Helfman does not teach each and every claim element

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

Claim 1 recites:

encoding an instruction in the markup language document, the instruction identifying a utility program that dynamically selects an image for insertion into the document...
(*Emphasis Added*).

The Office Action, with reference to the above limitation of claim 1, points to Figure 9 (items 152, 172 and 174) of Helfman as providing pertinent disclosure. Applicants strongly disagree that the identified items of Figure 9, or the accompanying text in the detailed description, of Helfman discloses the encoding of an instruction in a markup language document, the instruction identifying a utility program. Specifically Helfman describes the following, in pertinent part:

At step 152, the user fills in blank fields in the initialization web page. For example, the user may be asked to supply credit card and billing information before being allowed to proceed. The user also selects the desired method for

obtaining images. If the user selects the option "cache," the images are obtained from image cache memory 140. Images are drawn into cache 140 when users at clients 118, 120, and 122 use montage server process 136 on web server 124 to retrieve web pages with images (e.g., from web servers 126 and 128).
(Helfman, column 7, line 62 – column 8, line 4). (Emphasis Added).

Further:

If the user selects the option "search" at step 152, **the user is given an opportunity to enter search terms and a desired depth value at step 172.** The search terms and depth are preferably entered as part of the initialization information provided by the user. **Step 174 involves downloading montage applet 134 from web server 124 to client 122.** At step 176, a search engine is run by montage server process 136 based on the search terms supplied by the user. The search generates one or more web pages of search results. At step 178, montage server process 136 extracts a list of URLs from the search results web pages generated at step 176. If desired, a filter may be used at step 178 to ensure that the extracted URLs only correspond to sites other than the site of the search engine. Such a filter excludes links to commercial entities associated with the search engine service.
(Helfman, column 8, lines 41 -55). (Emphasis Added).

As will be noted from the above, the disclosures in Helfman are limited to receiving user input, such as credit card or billing information, into the blank field of an initialization web page, and search terms and a "depth value" for a search. Clearly, receiving user input does not amount to encoding an instruction in a markup language document. Furthermore, the user inputted information described at items 152, 172 and 174 of Figure 9 of Helfman does not identify a utility program. Specifically, the supply of requested credit card or billing information, or the supply of search terms, does not constitute information that identifies a utility program.

Certainly, this information does not identify the montage applet that is downloaded at step 174 of the disclosure provided by Helfman.

Claim 1 further recites:

selecting, by the utility program, a pre-determined number of images from a group of images, the pre-determined number being specified in the instruction...

(Emphasis Added).

The Office Action points to items 186 – 188 of Figure 9 of Helfman as providing relevant disclosure. Applicants have reproduced the relevant description of items 186 – 188 below for ease of reference:

Several concurrent processes are performed at step 184. During process 186, server process 136 **retrieves web pages based on the list of URLs** obtained from step 178 or 180 and the desired depth. Process 186 is an iterative process. If the desired depth is 0, only the web pages corresponding to the URL(s) on the list are retrieved. If the desired depth is greater than 0, additional layers of web pages are retrieved. For example, if the depth is 1, web pages corresponding to links appearing on the web pages for the depth of 0 case are retrieved in addition to the web pages for the depth of 0 case. If the depth is 2, a further layer of web pages is retrieved. As the web pages are retrieved, montage server process 136 identifies the image URLs that are embedded in the web pages and constructs a mapping list that maps each image URL to the URL of the web page associated with that image.

In process 188, montage server process 136 passes the image URL for each image to image server process 138, which retrieves the image. When the image has been fully retrieved, image server process 138 notifies montage server process 136 and

stores the image in image cache 140. In process 190, montage server process 136 transmits the completely retrieved images to montage applet 134 on client 122. If desired, images corresponding to web page URLs that match text strings indicative of pornographic or otherwise offensive or unwanted content can be excluded during process 190. Before transmitting the images, montage server process 136 obtains the user's criteria for undesired URLs (e.g., as part of step 152). Images corresponding to undesired URLs are then filtered out in process 190.

(Helfman, column 8, lines 65 – column 9, line 25). (Emphasis Added).

As stated above, Helfman does not disclose the encoding of an instruction, which identifies a utility program, in a markup language document. There is further clearly no disclosure of such an instruction specifying a pre-determined number of images from a group of images. Applicants note that Helfman does disclose that the input received at step 152 of Helfman may include a “desired depth value”. At process 186, as described by Helfman, layers of web pages are retrieved in accordance with this desired depth. The above text reproduced from Helfman describes how, for a depth of greater than zero, web pages corresponding to links appearing in a web page having a depth of zero are retrieved, in addition to web pages for the depth of zero.

Applicants again point out that a desired depth of value does not constitute an instruction that is encoded in a markup language document or that identifies a utility program. Furthermore, a depth value does not specify a pre-determined number of images; it merely specifies a depth, within a layering of web pages. This, in and of itself, is very different from a specification of a pre-determined number of images.

From the above discussion, it will be apparent that Helfman does not disclose at least the above-identified elements of claim 1, and the Office Action has accordingly failed to make out a *prima facie* case of anticipation against this claim.

Claim 25 includes elements (or limitations) having terminology corresponding substantially to the above discussed terminology of claim 1. For the same reasons provided above, Helfman does not teach at least the relevant limitations of claim 25, and the Office Action also fails to make out a *prima facie* case of anticipation against this claim.

Claim 19: Helfman does not teach each and every claim element.

Claim 19 recites:

an instruction embedded in a markup language document in the memory to cause the processing unit to execute a utility program from the computer-readable medium, wherein the utility program causes the processing unit to determine a number of images to display in the markup language document...
(*Emphasis Added*).

With respect to claim 19, the Office Action appears to have rejected claim 19 for the same reasons as claim 13. It will however be noted that the limitations of claim 13 are somewhat different from those of claim 19. Specifically, claim 19 calls for an instruction embedded in a markup language document, the instruction to cause a processing unit to execute a utility program. This utility program causes the processing unit to determine a number of images to display in the markup language document.

As discussed above with reference to claims 1 and 25, there is simply no disclosure in Helfman of an instruction being embedded in a markup language document, much less of such an instruction that causes execution of a utility program. Again, the user-provision of information into blank fields of a web page, or the user-entry of search terms into a blank field of a web page, do not constitute instructions that are embedded in a markup language document. Instead, such data merely constitutes input data.

Thus, Helfman again does not disclose at least the above-described limitation of claim 19, and the Office Action has failed to make out a *prima facie* case of anticipation against this claim.

Claim 13 and 26: Helfman does not teach each and every claim element

Claim 13 recites:

obtaining a set of random numbers corresponding to the number of images;

retrieving images from a group of images using the set of random numbers...
(Emphasis Added).

The Office Action, in its rejection of claim 13, identifies the following disclosures in Helfman as being pertinent:

Various techniques can be used to define the set of images that are presented on screen 12. If desired, the images can be obtained from an image cache. The contents of the cache varies continually as other users browse the Web and draw different images into the cache. **As new images are added to the cache, they are displayed on screen 12.** Because a variety of images are presented to the user without any user input, the user may browse the Internet or intranet passively. **Another way in which to obtain images is to perform a search for web pages that meet certain predefined search criteria.** The images displayed on screen 12 can be extracted from the web pages that match the search criteria. **Similarly, a user can provide a list of certain universal resource locators (URLs) to define a set of web pages or web sites.** The URLs can be entered by the user manually or by cutting and pasting from an application or can be supplied from a

web browser's bookmarks file. The web page images are obtained from the web pages associated with the list of URLs. **Web page images can also be obtained from web pages associated with the currently displayed page of an active web browser.**

(Helfman, column 3, lines 10 – 24). (Emphasis Added).

Further:

A montage application, such as montage application 40 on client 32, may run on each client in local area network 20, but is illustrated only as running on client 32 to avoid over-complicating the drawing. Montage application 40 parses the log file maintained by proxy server 38 and creates a corresponding mapping list containing the URLs of the images in cache 38 and the URLs of the web pages associated with those images. **Montage application 40 displays the images on the display of client 32 in a random pattern (e.g., as shown in FIG. 1), a non-overlapping pattern (e.g., as shown in FIG. 2), or in some other suitable arrangement.**

(Helfman, column 3, lines 55-65). (Emphasis Added)

As will be noted from the above excerpts, Helfman discloses that images, to be displayed on a screen, are obtained from a cache, from a search of web pages, from a user-provided list of URLs, or from a web page that is currently being displayed by a browser. Clearly, there is no disclosure in Helfman of obtaining a set of random numbers, corresponding to a number of images, and then retrieving images utilizing this set of random numbers. Applicants note that Helfman does describe the montage application (40) as displaying images in a random pattern. However, clearly this is very different from obtaining a set of random numbers, corresponding to a number of images, and then retrieving images, from a group of images, using the set of random numbers, as is required by claim 13.

Thus, Helfman does not disclose at least the above identified elements of claim 13, and the Office Action does not make out a *prima facie* case of anticipation with respect to this claim.

Claim 26 includes terminology corresponding substantially to the above described terminology of claim 13, and Applicants contend that claim 26 is also not anticipated by Helfman for the same reasons provided above.

Dependent claims: Helfman does not teach each and every claim element.

With respect to the claims that depend from independent claims 1, 13 and 19, as a dependent claim is deemed to include all limitations of a claim from which it depends, each of these dependent claims is similarly not anticipated by Helfman for the reasons provided above.

§103 Rejection of the Claims

Claim 24 was rejected under 35 USC § 103(a) as being unpatentable over Helfman in view of Inoue et al. (U.S. 2003/0208560).

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the

claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

M.P.E.P. § 2142 (citing In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

As claim 24, in light of its eventual dependency on claim 19, includes each of the elements of claim 19. Helfman, for the reasons listed above, does not teach all of the limitations of claim 19, and the Applicants accordingly contend that a *prima facie* case of obviousness has not been established with respect to claim 24.

Documents Cited but Not Relied upon for this Office Action

Applicants need not respond to the assertion of pertinence stated for the references cited but not relied upon by the Office Action since these references are not made part of the rejections in this Office Action. Applicants are expressly not admitting to this assertion and reserve the right to address the assertion should it form part of future rejections.

CONCLUSION

Applicants respectfully submit that all rejections and objections to the currently pending claims have been addressed, and that the claims are in condition for allowance. Notification to this effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-333-9972 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.


Respectfully submitted,

JENNIFER PEARSON ET AL.

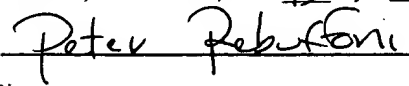
By their Representatives,

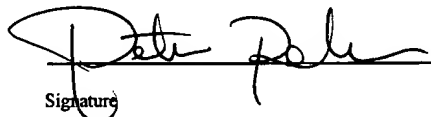
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
408-333-9972

Date 06/13/05

By 
Andre L. Marais
Reg. No. 48,095

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 13 day of June, 2005.


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